REMARKS

Summary of the Present Application

Claims 1-6 remain pending in the present application, and new claims 7-10 have been added. The Office Action rejected claims 1-3 and 6 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 4,670,782 to Harshbarger. Likewise, the Office Action rejected claims 4 and 5 under 35 U.S.C. § 103(a) as allegedly unpatentable over Harshbarger in view of U.S. Patent 4,093,960 to Estes. For at least the reasons set forth below, Applicant respectfully traverses these substantive rejections, and requests that they be withdrawn.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 1-3 and 6 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Harshbarger. Applicant respectfully traverses the 35 U.S.C. § 102(b) rejections for at the reason that **Harshbarger does not teach, disclose or suggest the claimed plurality of signal generator cards.**

Claim 1 specifically recites:

> 1. An apparatus for synchronously displaying patterns on panels during testing wherein the panels are driven by ***a plurality of signal generator (SG) cards***, the apparatus comprising:
> a synchronization activator generating a first signal;
> a pattern selector generating a second signal identifying one of the patterns; and
> ***a controller connected to the SG cards and simultaneously activating the SG cards*** driving all the panels to display the pattern identified by the second signal when receiving the first signal.

Likewise, claim 6 recites:

6. An apparatus for synchronously displaying patterns on panels during testing wherein the panels are driven by ***a plurality of signal generator (SG) cards***, the apparatus comprising:

a synchronization activator generating a first signal;

a pattern selector generating a second signal identifying one of the patterns, the pattern selector ***being independently operable*** from the synchronization activator; and

a controller connected to the SG cards and simultaneously activating the SG cards driving all the panels to display the pattern identified by the second signal when receiving the first signal.

(*Emphasis added.*) Applicant submits that independent claims 1 and 6 patently defines over the cited art for al least the reason that Canine does not teach or disclose the features emphasized above.

Harshbarger does not teach or suggest the SG cards disclosed in the present invention. (1) Each of the SG cards is connected to the controller by multiple signal lines and one control line for panel testing. The signal lines deliver the pattern data to the panel while the signal on the control line determines whether a pattern is selected. The SG cards of the embodiments of claims 1 and 6 are not disclosed anywhere in Harshbarger's disclosure.

Further, the controller in claims 1 and 6 is connected to the SG cards and simultaneously (2) activates the SG cards to drive the panels to display the pattern selected by the pattern selector when receiving the signal generated by the synchronization activator. The controller (CPU) of the video pattern generator proposed by Harshbarger does not perform the same process thus is not equivalent to the controller disclosed in the present invention. Consequently, the teachings of Harshbarger cannot form a proper basis for a rejection under 35 U.S.C. § 102(b).

Conclusion w/o explanation of how or the distinctes

Furthermore, according to claim 6, the synchronization activator and pattern selector operate independently from each other. The pattern selector just selects a pattern, which does not manipulate the pattern data for the synchronization activator. In contrast, the pattern selector and

Not in claims

the sync generator taught by Harshbarger are closely integrated into a single system, therefore, are structurally and functionally different from the subject matter defined by claim 6.

Conclusion
no explanation of how this differs from Applicant's invention

For at least these reasons, independent claims 1 and 6 patently define over the cited art, and the rejections of these claims should be withdrawn.

Claims 2-5 and 7-10 each depend from claims 1 and 6, and therefore define over the cited art for at least the same reasons.

In addition, claims 7 to 10 are newly added claims. According to claims 7 and 9, the controller simultaneously activates the SG cards to drive each of the panels to display the pattern identified by the second signal. At least two of the panels display the same pattern during testing. Whereas claims 8 and 10 further restrict claim 1 and 6 respectively so that all panels display exactly the same pattern during testing. As a result, the pattern identified by the second signal is repeatedly displayed on all panels. The additional features further define over the cited art, and for at least these additional reasons, the rejections of claims 7-10 should be withdrawn.

In response to the rejection to claim 3, claim 3 defines that "the pattern selector is a BCD keypad". According to the reasons given in the claim rejected under 35 U.S.C. 102 (b), the pattern selector is said to be replaceable by the pattern select switch and the pattern generator taught by Harshbarger. Harshbarger does not teach, disclose or suggest that the pattern select switch and the patter generator are BCD devices. It is not appropriate to point out that the microprocessor and keypad taught by Harshbarger are BCD devices as the keypad is not for pattern selection. Therefore, for at least this additional reason, the rejection of claim 3 should be withdrawn.

Claims 4 and 5 were rejected under 35 U.S.C. 103(a). Applicants respectfully traverse the combination of these references. In this regard, it is noted that significant technical features disclosed in the present invention are significantly different from the disclosures of Harshbarger. Therefore, combining the techniques disclosed in the video test pattern generator of Harshbarger and the test signal generating system of Estes would not lead an artisan to derive the claimed apparatus for synchronously displaying patterns on panels during testing.

In addition to the foregoing reasons, Applicant further submits that the rejection of claim 4 and 5 should be withdrawn, as the combination of Harshbarger and Estes is improper. It is well settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

> "The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art

references, the prior art must properly suggest the desirability of combining the particular elements to create an apparatus for synchronously displaying patterns on panels during testing, as specifically claimed by the Applicant.

In support of the combination of Harshbarger and Estes, the Office Action alleges only that "the motivation for doing so would have been to supply the needed potential to the system that would enable the operation of the system." Applicant respectfully traverses this alleged motivation. The undersigned is aware of no legal support (e.g, Federal Circuit precedent) for the proposition that enablement can form the basis of a combination of references. That is, it appears as though the Office Action may be implying that Harshbarger is non-enabling, and would be enabled by the combination of Estes. Such a motivation for the combination would be improper. Alternatively, the Office Action may be saying that Harshbarger fails to claim Applicant's invention (of claims 4 and 5), but that such would be enabled if Estes were combined with Harshbarger. Again, such a rejection would be improper, insofar as it is using Applicant's application as a roadmap for forming the rejection.

Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988). A description of the particular "teaching or suggestion or motivation [to combine]" is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys.*, Inc., 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, "the [Examiner] must identify specifically ... the reasons one of ordinary skill in the art would have been

motivated to select the references and combine them." *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed.Cir.1998). The Examiner can satisfy this burden of establishing obviousness in light of combination "only by showing some objective teaching [leading to the combination]." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992).

For at least these additional reasons, the rejections of claim 4 and 5 are misplaced and should be withdrawn.

CONCLUSION

Withdrawal of the rejections and allowance of the claims are respectfully requested. Applicant has made every effort to place the present application in condition for allowance. It is therefore earnestly requested that the present application, as a whole, receive favorable consideration and that all of the claims be allowed in their present form.

Should the Examiner feel that further discussion of the application and the Amendment is conducive to prosecution and allowance thereof, please do not hesitate to contact the undersigned at the address and telephone listed below.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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